

REMARKS

Claims 1-60 are pending. Claims 21, 31, 47, 51, and 60 have been amended. No claims have been canceled, and no new claims have been added. Claim 61 was canceled previously in a response to the first office action.

Disclaimers Relating to Claim Interpretation and Prosecution History Estoppel

Cosmetic amendments have been made to claims 21, 31, 47, 51, and 60. The amendments were not necessary for patentability.

The claims of this application are intended to stand on their own and are not to be read in light of the prosecution history of any related or unrelated patent or patent application. Furthermore, no arguments in any prosecution history relate to any claim in this application, except for arguments specifically directed to the claim.

Claim Rejections - 35 USC § 103

The office action rejected claims 1-5, 7-19, 21-25, 27-39, 41-45, and 47-59 under 35 USC § 103(a) as being unpatentable over Cho et al (US 6,834,048 B1) and Bertacchi (US 5,790,638). This rejection is respectfully traversed. It is well known that

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.” (MPEP 706.02(j)).

In this case, the office action fails to meet its burden of proving a *prima facie* case of obviousness as the office action fails to show that the prior art teaches or suggests all of the claim limitations.

Claim 1

The office action asserts that Cho teaches most of the limitations in claim 1 and that Bertacchi teaches the remaining limitation. We respectfully disagree.

Generally, Cho teaches allowing a caller to call a telephone number that he or she sees on a web page. More specifically, Cho teaches using a software program residing on a caller's computer to receive a web page and then parse the web page before the caller views the web page. (Cho, col. 1, lines 59-63). The software program searches and parses character strings in the web page to identify telephone numbers. (Cho, col. 1, lines 59-63). The software program on the caller's computer then transforms the telephone numbers into links that the caller can select to establish a call between the selected telephone number and the caller's personal computer. (Cho, col. 1, lines 63-67 & col. 2, lines 1-11).

The cited prior art does not teach or suggest all of the limitations of claim 1 for at least the following 4 reasons.

First, the office action fails to show that Cho teaches or suggests "transmitting the search request" and "receiving a search response responsive to the search request", "the search response including" "an ad having a dial link" as recited in claim 1. The office action states that "Cho explains that users may search the Web for contact phone numbers by using an input device and that it provides an automated, interactive and immediate real-time call connection capability for the web page user." (office action, page 2). However, the office action does not assert that Cho teaches or suggests "transmitting the search request" and "receiving a search response responsive to the search request", "the search response including" "an ad having a dial link". As such, the office action does not make a prima facie case of obviousness.

In addition, review of Cho shows that Cho does not teach or suggest "transmitting the search request" and "receiving a search response responsive to the search request", "the search response including" "an ad having a dial link" as recited in claim 1. In contrast, Cho discloses in step 404 of Figure 4 of Cho that a caller selects a URL and then a web page document is downloaded. Cho further discloses that "To access a particular web page, the caller specifies the URL of the desired

web page and the browser downloads the web page document associated with the URL (step 404).” (Cho, col. 5, lines 1-4). Importantly, Cho also discloses “parsing the web page document for detecting a character string indicative of a telephone number”, “modifying the character string”, and “providing the web page document including the modified character string to the browser”. (Cho, col. 1, lines 60-66). As such, Cho’s teaching is specific to downloading a **particular** web page document, onto the caller’s computer and then parsing that web page document on the caller’s computer before providing the web page to the caller. That Cho parses a received web page and modifies a character string before providing the web page to a caller shows that Cho does not teach or suggest “transmitting the search request” and “receiving a search response responsive to the search request”, “the search response including” “an ad having a dial link”. As such, claim 1 is patentable over Cho since Cho does not teach or suggest “transmitting the search request” and “receiving a search response responsive to the search request”, “the search response including” “an ad having a dial link” as recited in claim 1.

Second, the office action fails to show that Cho teaches or suggests the three components of the “search response” recited in claim 1, namely “at least one hit corresponding to the search request”, “an ad having a dial link, the dial link having a display portion for indicating availability of initiation of a phone call with a merchant associated with the dial link”, and “instructions for triggering a multi-leg phone call with a merchant phone number associated with the dial link and a user phone number”. The office action merely states that “Cho teaches that to place a call to a telephone number the caller selects the phone number by clicking on the underlined or highlighted text (ad, dial link)”. (office action, page 2). However, the office action wholly fails to assert that Cho teaches a “search response including” (1) “at least one hit corresponding to the search request”, (2) “an ad having a dial link, the dial link having a display portion for indicating availability of initiation of a phone call with a merchant associated with the dial link”, and (3) “instructions for triggering a multi-leg phone call with a merchant phone number associated with the dial link and a user phone number”. As such, the office action fails to make a prima facie case of obviousness.

In addition, Cho does not teach or suggest the three components of the “search response” recited in claim 1. Cho discloses “parsing the web page document for detecting a character string indicative of a telephone number”, “modifying the character string in the web page document into a link to the internet telephone service” and “providing the web page document including the modified character string to the browser.” (Cho, col. 1, lines 61-66). Cho’s teaching thus is specific to detecting telephone numbers on a web page, and then modifying those telephone numbers into links on the web page. In contrast, claim 1 recites, “a search response including” (1) “at least one hit corresponding to the search request”, (2) “an ad having a dial link, the dial link having a display portion for indicating availability of initiation of a phone call with a merchant associated with the dial link”, and (3) “instructions for triggering a multi-leg phone call with a merchant phone number associated with the dial link and a user phone number”. As such, Cho does not teach or suggest a “search response” including all three components recited in claim 1. Moreover, Cho also does not teach or suggest each of the three separate components of the “search response”.

More specifically, the first component of the search response recited in claim 1 is “a search response including at least one hit corresponding to the search request”. Cho does not teach or suggest “a search response including at least one hit corresponding to the search request”. Cho discloses “accessing the web page using a browser”. (Cho, col. 1, lines 59-60). Cho discloses, “After the caller installs the Direct Dial software program, the caller can then invoke the browser application and access the internet, selecting web sites she wishes to view. To access a particular web page, the caller specifies the URL of the desired web page and the browser downloads the web page document associated with the URL (step 404).” (Cho, col. 4, lines 66-67 & col. 5, lines 1-4). Cho thus teaches a caller selecting a particular web site. As such, Cho does not teach or disclose “a search response including at least one hit corresponding to the search request”.

The second component of the search response recited in claim 1 is “an ad having a dial link, the dial link having a display portion for indicating availability of initiation of a phone call with a merchant associated with the dial link”. The office action fails to assert that Cho teaches or suggests “a search response including” “an ad having a dial link, the dial link having a display portion for

indicating availability of initiation of a phone call with a merchant associated with the dial link". Even using the argument asserted in the office action regarding claims 11, 31, and 51, that Figure 5B of Cho shows a web page "having ad data" (office action, page 4), the office action still fails to show that Cho teaches or suggests "a search response including" "an ad having a dial link". Cho states that Figure 5B "illustrates the same [downloaded] web page **after** the operation of the direct telephone dialing scheme of the present invention. The character strings in the web page that have been underlined have been designated as telephone numbers and can be used to activate internet telephone service". (Cho, col. 6, lines 38-43) (emphasis added). Cho thus clarifies that Figure 5B shows a modified web page wherein the telephone numbers are links that a user can select to place a phone call to that number. Even if in arguendo this portion of Cho suggests a "dial link" as claimed, Cho explicitly teaches adding the dial link to a web page after it has been downloaded. As such, the downloaded web page of Cho can not teach or suggest "a search response including" "an ad having a dial link".

Further, Figure 5B shows "All Listings" for a yellow pages search result as stated in the Figure. However, a yellow page listing of phone numbers does not teach or suggest "a search response including" "an ad having a dial link". Stated more simply, a listing of addresses and phone numbers does not teach or suggest an "ad". As such, the office action also fails to show that Cho teaches or suggests "an ad having a dial link, the dial link having a display portion for indicating availability of initiation of a phone call with a merchant associated with the dial link".

In addition, Cho does not teach or suggest "an ad having a dial link, the dial link having a display portion for indicating availability of initiation of a phone call with a merchant associated with the dial link". Cho discloses "a method for initiating an internet telephone service from a web page containing **at least one telephone number**". (Cho, col. 1, lines 57-59) (emphasis added). Cho's teaching is specific to a web page with at least one telephone number. Cho nowhere recites "**an ad**". In contrast, claim 1 recites "a search response including" "an ad having a dial link". As such, Cho does not teach or suggest "an ad having a dial link, the dial link having a display portion for indicating availability of initiation of a phone call with a merchant associated with the dial link".

The third component of the search response recited in claim 1 is “instructions for triggering a multi-leg phone call with a merchant phone number associated with the dial link and a user phone number”. The office action fails to show that Cho teaches or suggests “instructions for triggering a multi-leg phone call with a merchant phone number associated with the dial link and a user phone number”. The office action states “Cho teaches that character strings indicative of a telephone number are modified into a link and then the system displays the telephone number.” (office action, pages 2-3). The office action further states “Cho teaches selecting and activating the link and initiating the telephone call to the telephone number represented by the link.” (office action, page 3). However, the office action does not show that Cho teaches or suggests “instructions for triggering a multi-leg phone call with a merchant phone number associated with the dial link and a user phone number”. As such, the office action fails to assert a prima facie case of obviousness because the office action does not show that Cho teaches or suggests “instructions for triggering a multi-leg phone call with a merchant phone number associated with the dial link and a user phone number”.

In addition, Cho does not teach or suggest “instructions for triggering a multi-leg phone call with a merchant phone number associated with the dial link and a user phone number”. Cho instead discloses “launching a server side script at the internet telephone service for initiating a telephone call to the telephone number”. (Cho, col. 2, lines 6-8). Cho also discloses that “the caller selects the designated telephone numbers by clicking on the underlined or hi-lighted text. **Because the designated telephone number is a link to an internet telephone service provider, selection of the telephone number launches the internet telephone service.**” (Cho, col. 6, lines 45-50) (emphasis added). Because a link to an ISP is not a user phone number, Cho fails to teach or suggest “a search response including” “instructions for triggering a multi-leg phone call with a merchant phone number associated with the dial link and a user phone number”.

Moreover, as shown in Figures 1A and 1B of Cho, Cho’s teaching focuses on making a phone call between a PC and a phone. Cho recites, “FIG. 1A illustrates one embodiment of a communication system for providing audio communication between a personal computer and an audio communication device.” (Cho, col. 2, lines 18-20). In addition, Cho recites, “FIG. 1B

illustrates another embodiment of a communication system for providing audio communication between a personal computer and an audio communication device where the personal computer is located behind a firewall.” (Cho, col. 2, lines 21-24). Cho’s teaching thus discloses modifying a telephone number on a web page into a link which when selected launches a server side script running on the internet telephone service’s server to place a call between the caller’s personal computer and the phone number selected. As such, Cho teaches only a merchant phone number, if anything, to which a caller’s personal computer is connected via the ISP. Therefore, Cho does not teach or suggest “a search response including” “instructions for triggering a multi-leg phone call with a merchant phone number associated with the dial link and a **user phone number**”. (emphasis added).

Third, the office action admits that Cho fails to teach “generating a call trigger in accordance with the instructions in the search response, the call trigger for initiating a multi-leg phone call with the user phone number and the merchant phone number” of claim 1, and that Bertacchi discloses this feature. However, claim 1 is distinguishable from Bertacchi.

Generally, Bertacchi discloses using a “telephone switch to respond to an incoming call made to a primary telephone number by simultaneously and/or sequentially calling one or more specified numbers.” (Bertacchi, col. 1, lines 61-64). More specifically, Bertacchi explains, “When the incoming call is received at the telephone switch, it recognizes that the calling party dialed primary number is associated with a subscriber desiring multi-leg calling. The switch responds by routing the incoming call over a number of different outgoing legs to the plurality of telephones at subscriber specified numbers.” (Bertacchi, col.1, lines 66-67 & col. 2, lines 1-5). Bertacchi’s teaching thus discloses creating multiple outgoing legs to a subscriber’s additional telephone numbers, after the initial call is placed. That is, after the first half of the call has already been completed, multiple second legs are created in order to establish a connection to the called party.

The office action fails to assert that Bertacchi teaches or suggests, “generating a call trigger in accordance with the instructions in the search response, the call trigger for initiating a multi-leg phone call with the user phone number and the merchant phone number.” The office action states

that Bertacchi teaches a system which “is responsive to an incoming call made to a primary telephone number subscribing to a call transfer service feature. The invention responds to an incoming call made to a primary phone number by simultaneously calling specified secondary numbers (multi leg calling)”. (office action, page 3). However, the office action fails to assert that Bertacchi teaches “generating a call trigger in accordance with the instructions in the search response, the call trigger for initiating a multi-leg phone call with the user phone number and the merchant phone number.” As such, the office action fails to make a prima facie case of obviousness.

Moreover, review of Bertacchi shows that Bertacchi does not teach or suggest “generating a call trigger in accordance with the instructions in the search response, the call trigger for initiating a multi-leg phone call with the user phone number and the merchant phone number.” As stated above, Bertacchi discloses creating a multi-leg call after the initial call is placed. Bertacchi teaches creating a multi-leg call by creating multiple outgoing call legs to the called party’s secondary numbers. This does not teach or suggest “generating a call trigger in accordance with the instructions in the search response, the call trigger for initiating a multi-leg phone call with the user phone number and the merchant phone number.” As such, Bertacchi does not teach or suggest “generating a call trigger in accordance with the instructions in the search response, the call trigger for initiating a multi-leg phone call with the user phone number and the merchant phone number.” Therefore, claim 1 is patentable over the combination of Bertacchi and Cho.

Finally, the office action asserts that “it would have been obvious to one ordinarily skilled in the art at the time the invention was made to modify Cho’s method for initiating phone calls to include Bertacchi’s teaching of placing a multi-leg phone call because a user can be reached at any of a plurality of specified telephone numbers maximizing the chance of being reached anywhere at any time.” (office action, page 3). However, as discussed above, Cho’s method for initiating phone calls is clearly distinguishable from claim 1. Similarly, Bertacchi’s teaching of placing a multi-leg phone call is also clearly distinguishable from claim 1.

Therefore, because the combination of Cho and Bertacchi do not teach or suggest all of the limitations of claim 1 as discussed above, claim 1 is patentable over the combination of Cho and

Bertacchi, and the rejection under 103(a) regarding claim 1 should be withdrawn.

Claims 41 and 51

The office action asserts that the same rejection as stated for claim 1 applies to claims 41 and 51. We respectfully disagree. To the extent claims 41 and 51 share limitations with claim 1, claims 41 and 51 are patentable over Cho and Bertacchi for the same reasons claim 1 is patentable over Cho and Bertacchi as set forth above.

Claims 11, 31, and 51

The office action asserts that the same rejection as stated for claim 1 applies to claims 11, 31, and 51. To the extent claims 11, 31, and 51 share limitations with claim 1, claims 11, 31, and 51 are patentable over Cho and Bertacchi for the same reasons claim 1 is patentable over Cho and Bertacchi as set forth above.

The office action further asserts that claims 11, 31, and 51 are also rejected based on Figure 5B in Cho. We respectfully disagree.

The office action asserts that Figure 5B shows “a web page displaying links having ad data including content information, address and telephone number are shown.” (office action, page 4). Further, as stated above in the discussion regarding claim 1, Cho states that Figure 5B “illustrates the same web page after the operation of the direct telephone dialing scheme of the present invention. The character strings in the web page that have been underlined have been designated as telephone numbers and can be used to activate internet telephone service”. (Cho, col. 6, lines 38-43). Cho thus clarifies that Figure 5B shows a modified web page wherein the telephone numbers are links that a user can select to place a phone call to that number. As such, Figure 5B fails to teach or suggest “a displayable ad based upon the ad content information, the ad further having a dial link, the dial link having a display portion for indicating availability of initiation of a phone call with a merchant associated with the dial link” as recited in claims 11, 31, and 51. Moreover, Cho does not teach or suggest all of the limitations of claims 11, 31, and 51 including “a displayable ad based upon the ad content information, the ad further having a dial link, the dial link having a display portion for

indicating availability of initiation of a phone call with a merchant associated with the dial link". As such, the office action fails to make a prima facie case of obviousness.

In addition, Cho does not teach or suggest "a displayable ad based upon the ad content information, the ad further having a dial link, the dial link having a display portion for indicating availability of initiation of a phone call with a merchant associated with the dial link". Figure 5B of Cho merely shows a Yellow Pages phone book listing. However, a Yellow Pages phone book listing is not "a displayable ad" "having a dial link, the dial link having a display portion for indicating availability of initiation of a phone call with a merchant associated with the dial link". As such, Cho does not teach or suggest "a displayable ad" "having a dial link, the dial link having a display portion for indicating availability of initiation of a phone call with a merchant associated with the dial link" as recited in claims 11, 31, and 51.

Because the combination of Cho and Bertacchi do not teach or suggest all of the limitations of claims 11, 31, and 51 as discussed above, claims 11, 31, and 51 are patentable over the combination of Cho and Bertacchi, and the rejection under 103(a) regarding claims 11, 31, and 51 should be withdrawn.

Claim 21

The office action asserts that the same rejection as stated for claim 1 applies to claim 21. To the extent claim 21 shares limitations with claim 1, claim 21 is patentable over Cho and Bertacchi for the same reasons claim 1 is patentable over Cho and Bertacchi as set forth above.

The office action further asserts that claim 21 is also rejected based on Figure 1A in Cho which teaches a computer "having display screen, input device, processor, memory and display screen." We respectfully disagree.

Claim 21 recites, among other limitations, "an ad having a dial link, the dial link having a display portion for indicating availability of initiation of a phone call with a merchant associated with the dial link". While Figure 1A of Cho shows a computer having a display screen, input device, processor, memory and display screen, Cho does not teach or suggest all of the limitations of claim

21 including “an ad having a dial link, the dial link having a display portion for indicating availability of initiation of a phone call with a merchant associated with the dial link”.

Because the combination of Cho and Bertacchi do not teach or suggest all of the limitations of claim 21 as discussed above, the office action fails to meet its burden of proving a prima facie case of obviousness. Therefore, claim 21 is patentable over the combination of Cho and Bertacchi and the rejection under 103(a) regarding claim 21 should be withdrawn.

Claims 2-5, 7-10, 12-19, 22-25, 27-30, 32-39, 42-45, 47-50, 52-59

By virtue of their dependency on the independent claims, the dependent claims are patentable over the cited references for the reasons cited above. As such, claims 2-5, 7-10, 12-19, 22-25, 27-30, 32-39, 42-45, 47-50, and 52-59 are patentable over the cited references by virtue of their dependency on independent claims 1, 11, 21, 31, 41 and 51.

The Examiner rejected claims 6, 20, 26, 40, 46 and 60 under 35 USC § 103(a) as being unpatentable over the combination of Cho/Bertacchi and Musk et al (US 6,185,194 B1). This rejection is respectfully traversed.

As stated above, in order to prove a prima facie case of obviousness, the prior art references must teach or disclose all of the claim limitations. In this case, the office action fails to meet its burden of proving a prima facie case of obviousness as the office action fails to show that the prior art teaches or suggests all of the claim limitations.

Claims 6, 20, 26, 40, 46, and 60

The office action admits that Cho/Bertacchi do not teach “sending a message to a billing system to charge the merchant for the user activating the dial link”, but that Musk discloses this feature. We respectfully disagree.

Musk discloses, “The business directory typically already provides reverse billing for the listing, and thus can be used like an 800 service, to bill the business for the telephone call instead of the user.” (Musk, col. 2, lines 5-8). Musk thus discloses the concept of reverse billing where the business is billed for the telephone call instead of the user.

The office action fails to show that Musk teaches or suggests “sending a message to a billing system to charge the merchant for the user activating the dial link” as recited in claims 6, 26, and 46. The office action states that Musk “teaches that a web site accessed to place a call has a directory with a phone icon for a business to allow call initiation; the web site contains billing information and the business directory provides reverse billing and can be used to bill the business for the telephone call instead of the user.” (office action, page 6). However, the office action fails to assert that Musk teaches or suggests “sending a message to a billing system to charge the merchant for the user activating the dial link” as recited in claims 6, 26, and 46. That is, that Musk teaches billing a business for a telephone call placed to the business neither teaches nor suggests, “charg[ing] the merchant for the user **activating the dial link**” as claimed. (emphasis added). As such, the office action fails to make a prima facie case of obviousness. Similarly, the office action fails to assert that Musk teaches or suggests “sending a message to a billing system for charging for triggering the

multi-leg phone call” as recited in claims 20, 40, and 60. That is, that Musk teaches billing a business for a telephone call placed to the business neither teaches nor suggests, “for charging **for triggering the multi-leg phone call**” as claimed. (emphasis added).

In addition, review of Musk shows that Musk does not teach or suggest “sending a message to a billing system to charge the merchant for the user activating the dial link” as recited in claims 6, 26, and 46. Musk discloses a web site having a business directory wherein the business directory “provides reverse billing for the listing, and thus can be used like an 800 service, to bill the business for the telephone call instead of the user”. (Musk, col. 2, line 6-9). However, Musk does not teach or suggest “sending a message to a billing system to **charge the merchant for the user activating the dial link**” as recited in claims 6, 26, and 46. (emphasis added). That is, that Musk teaches billing a business for a telephone call placed to the business neither teaches nor suggests, “charg[ing] the merchant for the user **activating the dial link**” as claimed. (emphasis added). Similarly, Musk does not teach or suggest “sending a message to a billing system **for charging for triggering the multi-leg phone call**” as recited in claims 20, 40, and 60. (emphasis added). That is, that Musk teaches billing a business for a telephone call placed to the business neither teaches nor suggests, “for charging **for triggering the multi-leg phone call**” as claimed. (emphasis added).

Because the combination of Cho/Bertacchi and Musk do not teach or suggest all of the limitations of claims 6, 20, 26, 40, 46, and 60 as discussed above, the office action fails to meet its burden of proving a prima facie case of obviousness. Therefore, claims 6, 20, 26, 40, 46, and 60 are patentable over the combination of Cho/Bertacchi and Musk and the rejection under 103(a) regarding claims 6, 20, 26, 40, 46, and 60 should be withdrawn.

Conclusion

It is submitted, however, that the independent and dependent claims include other significant and substantial recitations which are not disclosed in the cited references. Thus, the claims are also patentable for additional reasons. However, for economy the additional grounds for patentability are not set forth here.

Appl. No. 10/821,467
Amdt. Dated 5/8/2006
Response to Office action dated 02/07/2006

In view of all of the above, it is respectfully submitted that the present application is now in condition for allowance. Reconsideration and reexamination are respectfully requested and allowance at an early date is solicited.

The Examiner is invited to call the undersigned attorney to answer any questions or to discuss steps necessary for placing the application in condition for allowance.

Respectfully submitted,



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Amdt. Dated 5/8/2006
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APPENDIX A

A replacement sheet of Figure 2 is attached.

Replacement Sheet

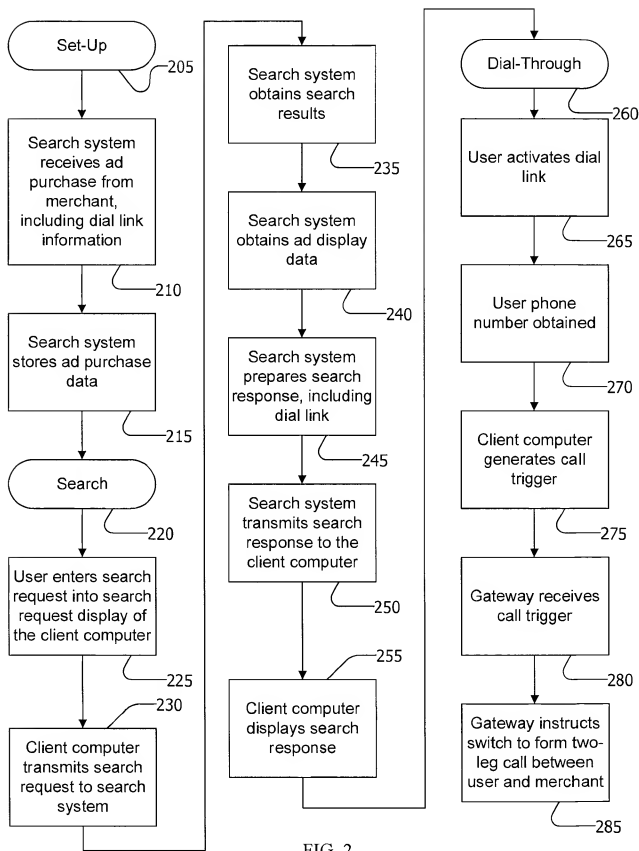


FIG. 2